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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/681,722   | 05/25/2001  | Gregory R. Wyatt     | 41 EB-1035          | 1673             |
| 23465  | 7590        | 07/20/2005           | EXAMINER            |                  |
| JOHN S. BEULICK<br>C/O ARMSTRONG TEASDALE, LLP<br>ONE METROPOLITAN SQUARE<br>SUITE 2600<br>ST LOUIS, MO 63102-2740 |             |                      | KYLE, CHARLES R     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3624                |                  |

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/681,722

Applicant(s)

WYATT, GREGORY R.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-9,12-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-9, 12-17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5-9, 12-17 and 19-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement and as based on a disclosure which is not enabling. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Neither the claims nor the specification clearly describe what the initial regression equations are or how the server actually combines them. The initial regression equations are critical or essential to the practice of the invention, but what the equations are or how they are combined is not included in the claims and is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1-976). For example, if someone were to infringe the present invention, they would not know how they were infringing it because how the equations are combined, what the initial equations are or how the server combines them is not clearly defined; the actual metes and bounds of the present invention are not clearly established. This rejection was set out in the previous office action and is maintained. See Response to Arguments.

***Claim Rejections - 35 USC § 101***

The rejections under 35 USC § 101 of Claims 17-21 of the prior office action are withdrawn based on Applicants' amendments.

***Response to Arguments***

Applicant's arguments filed February 16, 2005 have been fully considered but they are not persuasive.

Applicants attempt to traverse the rejection under 35 USC 112, first paragraph at pages 7-9 of Remarks. At page 7, fifth para. to page 8, Applicants first attempt to explain development and combination of initial regression equations. They cite paras. 22, 23, 25, 28 and Figs 4 and 6 to support their argument. However, these citations merely restate that initial regression equations are developed and combined. The cited passages do not disclose any detail that would let one understand how equations are developed and/or combined. Not even a generalized formula or algorithm is provided to inform one of the initial regression equations. The combination element of the claims is hardly addressed. While the final regression equation is presented in some detail, how this equation is obtained would be mere guesswork, given the Specification. All of Applicants' arguments hinge on whatever detail is present in the final regression equation; this reflects the absence of disclosure of development and combination of the initial regression equations. A simple example will make the problem even more clear.

Assume that a "schematic" regression equation aspect of the invention is as follows:

**Initial Regression equation (1)**

“combined with”

**Initial Regression equation (2)**

“combined with”

**Initial Regression equation (3)       $\Longrightarrow$  Final regression  
equation**

•

•

“combined with”

**Initial Regression equation (n)**

The final regression equation is presented in some specificity at para. 26 of the Specification, and so we have some understanding of what that might encompass. Nowhere in the Specification is there any slightly comparable detail of the initial regression equations. Elements of development and combination of the initial regression equations to the left of the above arrow are absent from the Specification.

Nowhere in the Specification is there any detail of how these initial regression equations are “combined”. Combination could be anything from a simple list to a sophisticated combinatorial algorithm. Applicants cannot argue these latter points because the Specification

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contains no information on initial regression equation development or combination; we are only told that these somehow occur.

Applicants attempt to argue that development of initial regression equations are disclosed at page 9, first full para. by citing detail of the *final* regression equation. This tells us nothing about the initial regression equations. Applicant states that the initial regression equations for suppliers are based on product list information and pricing data, but does not show how the equations relate to these variables.. Applicants do not even attempt to mathematically relate the initial equations to the final equation.

At the following para., Applicants assert that the Specification describes combination to reach the final equation but do cannot cite any particular algorithm or formula to do the combination.

The Claims are so broad and the Specification so lacking in detail of the development and combination elements that application of prior art in an art rejection is precluded. See *In re Steele*, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk  
July 13, 2005

Examiner Charles Kyle

A handwritten signature in black ink, appearing to read "Charles Kyle", with a stylized flourish at the end.